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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,186	12/28/2001	Harish Mahalingam	680.0054USU	7732

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EXAMINER

FLOOD, MICHELE C

ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/034,186	Applicant(s) MAHALINGAM ET AL.	
	Examiner Michele Flood	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8,11-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 4,5 and 14-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,11-13 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the vehicle species of fatty alcohols in the reply filed on January 18, 2005 is acknowledged.

The claims have been examined, insofar, as they read on the elected invention, namely coconut water (topical lightening agent) and fatty alcohols (vehicle).

Election/Restrictions

This application contains claims 4 and 14-30 drawn to an invention nonelected with on June 23, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6, 8-11 and 32 are under examination.

Claim Rejections - 35 USC § 112

Claims 1, 6, 8-11 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly applied as necessitated by amendment.

Claim 1 recites the limitation "the skin" in line 10. There is insufficient antecedent basis for this limitation in the claim.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

Claim Objections

Claim 1 is objected to because of the following informalities: There is apparent misspelling in Claim 1, line 2. Applicant may overcome the objection by replacing "inhabit" with inhibit.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 11-13 as amended are rejected under 35 U.S.C. 102(b and/or e) as being anticipated by Golz-Berner et al. (N or *A). Newly applied as necessitated by amendment.

Applicant claims a composition comprising a topical lightening agent in an amount effective to inhibit DOPAchrome tautomerase, DHICA polymerase, or both, wherein the topical lightening agent has a melanin synthesis-regulating agent selected from the group consisting of coconut water, palm water, concentrates of the foregoing, and any combinations thereof; and a vehicle, wherein the vehicle is selected from the group consisting of vegetable oils, esters, alcohols, fatty alcohols, isoparaffins, silicone oils, polyols, and mixtures thereof, wherein the composition is applied to skin.

Golz-Berner (*A, used herein for convenience) teaches a composition comprising 0.5% of coconut water and the fatty alcohol vehicles of Steareth-2 and Steareth-21. See Example 1, in Column 6, lines 26-58. Golz-Berner does not teach the coconut water comprising the referenced composition as a topical lightening having the claim-designated functional effect. However, the composition taught by Golz-Berner comprises the one and the same ingredient in the same percentage amounts as instantly claimed by Applicant; therefore, the functional effect must be inherent to the composition taught by Golz-Berner.

The reference anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Golz-Berner et al. (N or *A) in view of Miyazaki et al. (O).

Applicant claims a composition comprising a topical lightening agent in an amount effective to inhibit DOPAchrome tautomerase, DHICA polymerase, or both, wherein the topical lightening agent is present at about 0.001 wt% to about 20 wt% by weight based on the total weight of the composition, wherein the topical lightening agent has a melanin-synthesis-regulating agent selected from the group consisting of coconut water, palm water, concentrates of the foregoing, and any combinations thereof, and wherein the topical lightening agent has a melanin uptake inhibiting agent of an aqueous Perilla extract in an amount effective to inhibit the transfer of melanin from melanocytes to keratinocytes; and a vehicle.

The teachings of Golz-Berner are set forth above. Golz-Berner teaches the instantly claimed composition except for an aqueous extract of Perilla. However, it would have been obvious to one of ordinary skill in the art to add an aqueous extract of Perilla to the composition taught by Golz-Berner to provide the instantly claimed invention because at the time the invention was made Miyazaki taught a composition comprising an aqueous extract of Perilla that was useful as a stable melanism inhibitor in the making of skin-lightening compositions. At the time the invention was made, one of ordinary skill in the art would have been motivated and one would have had a

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reasonable expectation of success to add the composition comprising the aqueous extract of Perilla to the composition taught by Golz-Berner in the making of the instantly claimed composition because Miyazaki taught that compositions comprising an aqueous extract of the leaf of Perilla inhibited the generation of tyrosinase activity which plays a central role in melanin generation and that compositions comprising the referenced melanin inhibitor was useful in the making of cosmetic compositions for topical application to the skin for a whitening effect, in [0017] and [0023]; and, Golz-Berner teaches that compositions comprising coconut water and fatty alcohols are useful in the making of cosmetic compositions having excellent moisturizing, pH-adjusting and soothing effects with a long-lasting effect, in Column 2, lines 9-21; and, furthermore, Golz-Berner suggests adding biogenic plant extracts as additive and/or active agents in the making of the referenced composition, in Column 2, lines 36-46.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

No claims are allowed.

* Applicant is advised that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Should you receive inquiries about the use of the Office's PAIR system, applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MICHELE FLOOD
PRIMARY EXAMINER

MCF

March 17, 2005